



20 FEB 2003

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In re Application of TATO et al :
U.S. Application No.: 10/088,678 :
Int. Application No.: PCT/IT00/00373 :
Int. Filing Date: 21 September 2000 : DECISION
Priority Date: 21 September 1999 :
Attorney Docket No.: 4161-2 :
For: METHOD FOR THE SELECTIVE :
PROTECTION OF PROLIFERATING :
NORMAL CELLS AND THE SELECTIVE :
ERADICATION OF TUMOR CELLS HAVING :
AN INACTIVE p53 PATHWAY :

This is in response to applicant's "Renewed Request for Status Under 37 CFR §1.42"
filed 13 February 2003.

BACKGROUND

On 21 September 2000, applicant filed international application PCT/IT00/00373, which claimed priority of an earlier Italy application filed 21 September 1999. A copy of the international application was communicated to the USPTO from the International Bureau on 29 March 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 18 April 2001, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 21 March 2002.

On 21 March 2002, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 18 June 2002, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration and a sequence listing must be filed.

On 16 October 2002, applicant filed a request for status under 37 CFR 1.42 along with an executed declaration.

On 30 December 2002, this Office mailed a decision dismissing the 16 October 2002 request for status on grounds that the submitted declaration was improper.

On 13 February 2003, applicant filed the present renewed request for status under 37 CFR 1.42 along with a newly executed declaration.

DISCUSSION

37 CFR 1.42 provides, "In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent."

Effective 07 November 2000, 37 CFR 1.497(b)(2) specifies that, where a person making the declaration is the legal representative of a deceased inventor, the declaration shall state the following: (1) the relationship of the person to the inventor, (2) the facts the inventor would have been required to state, upon information and belief, (3) that the person is the legal representative of the deceased inventor, and (4) the citizenship, residence, and mailing address of the legal representative.

In the present case, the declaration filed 13 February 2003 is improper. Specifically, although the sole heirs Claudia Della Valle Simoni, Alessandro Tato, and Francesco Tato may sign the declaration on behalf of the deceased inventor Franco Tato, the names of the heirs may not be listed under the heading "Inventor:". Furthermore, the declaration either fails to state the citizenship of Franco Tato as required by 37 CFR 1.497(a)(3) or fails to state the citizenship of the legal representatives as required by 37 CFR 1.497(b)(2). It cannot be determined whether the indication of "Italian" for the citizenship applies to the inventor or to the legal representatives. Note that a single indication cannot be used for both the inventor and the legal representative.

CONCLUSION

For the reasons above, the renewed request for status under 37 CFR 1.42 is DISMISSED without prejudice.

If reconsideration on the merits of the request for status is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Request for Status Under 37 CFR 1.42". No petition fee is required.

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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